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	First Named Inventor	Dale F. McIntyre et al.
	Art Unit	3722
	Examiner Name	Monica S. Carter
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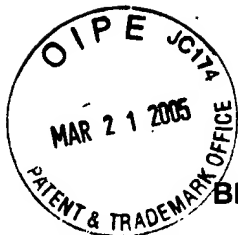
ENCLOSURES (Check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/ Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Check for \$500.00
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Docket No.: 82466RLO (822.1195)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re the Application of:

Dale F. McIntyre, et al.

Serial No. 09/845,589

Group Art Unit: 3722

Confirmation No. 2441

Filed: April 30, 2001

Examiner: Monica S. Carter

For: FORMING A SCRAPBOOK PAGE WITH IMAGES OF DIFFERENT
CHARACTERISTICS

APPEAL BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

03/23/2005 EABUBAK1 00000007 09845589

Sir:

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In response to the Final Office Action in the above-identified application, and pursuant to the Notice of Appeal filed January 19, 2005, Applicants submit this Brief with the fee of \$500.00 set forth by 1.17(c).

(I) Real Party In Interest

The real party in interest in this appeal is the assignee Eastman Kodak Company.

(II) Related Appeals and Interferences

The undersigned attorney, the appellant and the assignee know of no related appeals or interferences which would be directly affected by or directly affect or have a bearing on the Board's decision in this appeal.

However, this is the second Appeal Brief filed in this application, the prior final Action having been withdrawn and a new grounds of rejection entered.

(III) Status of Claims

Claims 1, 3, 4, 6, 8, 10 -15, 17, 18 and 20-27 are currently pending, no claims have been allowed, claims 2, 5, 7, 9, 16 and 19 have been cancelled, claims 1, 3, 4, 6, 8, 10-15, 17, 18 and 20-27 stand finally rejected and claims 1, 3, 4, 6, 8, 10-15, 17, 18 and 20-27 are appealed.

03/22/2005 EABUBAK1 00000025 09845584

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Adjustment date: 03/23/2005 EABUBAK1
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(IV) Status of Amendments

No amendments have been filed subsequent to the final rejection.

(V) Summary of the Claimed Subject Matter

The present invention (see specification pages 4-9) is directed to creating a page of a scrapbook using an image, such as a snapshot. Scrapbooks holding snapshots have been around for a long time. To make a scrapbook product interesting in this environment, the inventor recognized that the product must stand out above others. The inventor has also recognized that an important aspect of a scrapbook page is the personal nature of the image. As a result, the invention allows the image used in the scrapbook to essentially be supplied by the scrapbook maker (page 4, line 7). In further consideration of the personal nature of the page, the inventor has recognized that the scrapbook page is also a personal statement about the image being used. As a result, the invention allows the user to customize the image and the scrapbook page in a number of different ways by giving the versions of the image (or scrapbook page) different characteristics or arrangements/styles (page 4, line 6 - page 6, line 2 and figures 1A-1C). The inventor has also recognized that an important aspect of adding value to a product is in making the product entertaining. As a result, the invention provides activities for the scrapbook maker (scrapbooker) to perform as part of its entertainment value. These activities could be called paper craft activities and include manually cutting out the photographic images and arranging them in a one of a number of creative, artful, visually pleasing layouts and adhesively sticking them to the scrapbook page (page 8, line 30 - page 9, line 7 and figure 7). These activities can improve the manual dexterity of the young and maintain it for the aged, a benefit of the invention in addition to its entertainment value. The inventor has recognized that it is important for the activity of creating a scrapbook to be accessible to a broad range of scrapbook makers, old and young people, and be capable of involving a number of family members in the activity or be a solo activity. The inventor further recognizes that a creative and entertaining scrapbook page can be made to the satisfaction of users or page makers even when the creative nature of the page is constrained. The invention also recognizes that not every person is extremely creative and a product that allows substantially everyone to essentially be creative has great value. To allow both young and old, families and individuals, the creative and the not so creative to make a creative scrapbook page, the inventor recognized that some of the makers could benefit from help. As a result, the invention essentially comes with a set of instructions (page 5, line 25 - page 6, line 2 and figure 1C). The invention also allows the user to select from a limited set of creative image sets or series (products or scrapbook styles) (page 6, lines 3-14 and figure 2 or page 6, line 17 - page, line 7 and figure 3). This selection can be iterative in the sense that the user can change his/her mind (page 6, lines 25-27) also adding to

the interactive entertainment value. The inventor also recognized that when the very young are involved in the activity of creating the page the instructions might become lost or forgotten frustrating the user. As a result, the instructions are printed or produced together with the creative images (page 5, line 25 - page 6, line 2 and figure 1C) on a single medium or substrate. As noted above, an important aspect of the present invention is its entertainment value and entertainment should not be frustrating. Today, value is added to products by making them entertaining, easy to use and not frustrating. The present invention accomplishes this.

To attain the above discussed product values, in the present invention, the user, such as a mom creating a "scrapbook" with her child, supplies a photograph which is converted into a "photographic digital image" (see claim 1, where claim 1, when a claim is not specified, is used for illustrating the nature of the invention in this summary). The mom can then specify ("specified") the types of creative images or styles that are to be created for the scrapbook from the supplied image, such as a zoom, kaleidoscope, a layer print, etc. The system, based on the specification or style, makes ("forms") a "series" of images (at least two) from the supplied image where each of the images, from the "same" image, in the series has "different characteristics." In the zoom example (figure 1A), a series of images of progressively smaller sizes are created from the supplied image. This series of images is formed on a "photographic print medium" which is "distinct" from the composite image assembled on the scrapbook page. That is, the photographic medium is not the scrapbook page but the source of the material used for creating composite image to be assembled on the scrapbook page. The system also produces or selects ("automatically" – claim 27) a set of assembly "instructions" for making the scrapbook page specified or "style" scrapbook page (claim 25) where the instructions are designed to allow the user (mom and child in our example) to create or make ("making") the actual scrapbook page in the desired creative style. In the zoom style case the instructions describe how to "manually cut out" a portion of each of the zoom images (cut out the largest picture, for example), to stick ("manually fix") the images on a page in a certain overlapping sequence (arrange in a layered fashion, for example). These instructions along with the photographic images having the different characteristics are printed ("forming") on the same photographic print medium ("single" photographic print medium) and supplied to the user (the mom and birthday girl in our example). That is, a single photographic print has both the images and the instructions for creating a composite image on a scrapbook page. The user (the mom and the birthday girl in this example) then can follow the instructions ("allowing ... in accordance with the instructions") to assemble the scrap book by manually cutting out ("manually cut out") the images and sticking ("fix") them to and arranging them on the scrapbook page in a "composite image on the page" (figure 7). The result is a manually created composite image (figure 7) that is created by the

birthday girl and her mom. Thus, the present invention provides a product that is easy to use by young and old, unique as well as entertaining by allowing the user to participate.

(VI) Grounds Of Rejection To Be Reviewed On Appeal

Claims 1, 3, 4, 6, 8, 10-15, 18 and 23-27 stand rejected under 35 USC section 103(a) as being unpatentable over <http://film.jcpennyporraits.com> (hereinafter "FJCP") in view of US Patent 5,712,005 by Monn (hereinafter "Monn")

Claims 20-22 stand rejected under 35 USC section 103(a) as being unpatentable over FJCP, in view of Monn and in further view of US Patent 6,324,545 by Morag (hereinafter "Morag").

(VII) Argument

A. The Law

Under Graham v. John Deere Co., 383 U.S. 1,148 U.S.P.Q. 459 (1966) the scope and content of the prior art are to be determined, the differences between the prior art and the claims at issue are to be ascertained and the level of skill in the art is to be ascertained. Against this background the obviousness of the subject matter is determined. The prior art must not only suggest the desirability that the teachings of references be combined but must also suggest the desirability of the modifications in the manner proposed by the Examiner as well as the results to be achieved (see Ex parte Costa, 211 U.S.P.Q. 636 (P.O.Bd.App.1978), ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572,221 U.S.P.Q. 929 (Fed.Cir.1984), In re Gordon, 733 F.2d 900,221 U.S.P.Q. 1125 (Fed.Cir.1984), Lear Siegler v. Aeroquip Corp., 733 F.2d 881,221 U.S.P.Q. 1025 (Fed.Cir.1984) and Diversitech v. Century Steps,850 F.2d 675,7 U.S.P.Q.2d 1315 (Fed.Cir.1988)). Effect must be given to all claim limitations (see In re Angstadt and Griffin, 537 F.2d 498,190 U.S.P.Q. 214 (C.C.P.A.1976)). The differences between the claimed invention as a whole and the prior art must be considered. It is error to focus on a core or gist of an invention (see Bausch & Lomb, Inc. v Barnes-Hind/ Hydrocurve, Inc., 796 F.2d 443,230 U.S.P.Q. 416 (Fed.Cir.1986)). "[T]he best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight." In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Factors to be considered in determining that claims are not obvious include unexpected results, new features, solution of a different problem and novel properties (see In re Wright, 848 F.2d 1216, 6 U.S.P.Q.2d 1959 (Fed.Cir.1988)). It is inappropriate to rely on general principles of engineering or physics or common understanding to fill in the gaps in the teachings of a

reference (see Panduit v. Dennison, 774 F.2d 1082, 227 U.S.P.Q. 337 (Fed.Cir.1985) and Akzo v. Dupont, 810 F.2d 1148, 1 U.S.P.Q.2d 1704 (Fed.Cir.1987)).

B. The Rejections

Claims 1, 3, 4, 6, 8, 10-15, 18 and 23-27 stand rejected under 35 USC section 103(a) as being unpatentable over FJCP in view of Monn

Claims 20-22 stand rejected under 35 USC section 103(a) as being unpatentable over FJCP, in view of Monn and in further view of Morag.

C. The Art

FJCP

<http://film.jcpennyportraits.com> (FJCP) is directed at a web page associated with portraits. The Board is requested to note that a current version of the site is available for review and "looks" much like the reference. The page shows different versions of a particular picture on an FJCP "Portrait" page, much like many individuals can obtain for school pictures at a school. The pictures are shown to come in sheets with several pictures, limited to two different sizes being possible on a sheet. There are no instructions on the portrait page concerning how to create the sheet of photographs, what to do with the sheets of photographs, etc. and, based on this FJCP art currently being used to reject some of the claims, one would have to inappropriately turn to and rely on common understanding as to what to do with such sheets. The current version of the portrait ordering site is located at:

<http://www.jcpportraits.com/html/sizes.shtml>

The FJCP system also includes a Portrait Greeting Cards page on which at least one characteristic of a greeting card, such as available greetings, is shown. The sample greeting card includes a greeting "Happy Easter" and a picture of a baby. As depicted on the FJCP greeting card page, on the right upper side in the "Birthdays" category of greetings shows a circle with a darkened center. There is no description of what this darkened circle means or how it was darkened. On this page, there are also no instructions as how to perform this selection process or as to what to do with the photograph or as to what to do with the card. Based on the FJCP art currently being used to reject some of the claims, one would have to inappropriately turn to and rely on common understanding as to these issues.

The FJCP reference appears to provide the picture on a photographic medium picture/paper stock and the greeting on a card paper stock to which the photograph is attached. This appears to be the case because the picture is shown with a shadow relief surrounding the photograph and because the "texture" of the photograph is different from that of the photograph. In addition, as these are greeting cards combined with a photograph, it would be natural and

expected for the card to be on card stock that allows the characteristic features of a greeting card to be reproduced, such as fancy graphics, raised relief decorations, feathered edges, etc. And it would be natural and expected for the photo to be on photo stock paper where a high quality of the image can be reproduced, as would be expected by a new grandmother receiving a picture of her new baby grandson. This position that the photo and greeting are on different types of stock is supported by the current JC Penny greeting card web site:

<http://www.jcpportraits.com/html/greetingcards.shtml>

to which the Board is invited to go. On this site, the card is shown as having a card stock feathered edge around the photo indicating that the photo is inserted into a pocket in the card stock. The current site depiction is generally consistent with the reference depiction.

Thus, it is submitted that FJCP shows a greeting card where a photo is printed on a photographic stock, a greeting is printed on a card stock and the two different paper stocks are combined into the greeting card.

Monn

Monn is directed to a kit for decorating a photo album storage box to identify the content of the photo album. The kit includes the photo album, the storage box, adhesives, etc. and also comes with a separate instruction sheet 20. The instruction sheet 20 includes instructions for "...making a color photocopy from a color photograph, applying adhesive to the front and back sides of the photocopy, pasting the photocopy to the outside surface 42 of the box 14, applying a protective layer of the acrylic gel to the pasted photocopies, and staining the protective acrylic finish with diluted permanent ink." (See col. 3, lines 48-55). The discussion notes that it is preferred that the edges of the photocopy be torn to tear off the border, although there are no instructions on the instruction sheet to do so. Because the instructions are separate from the activity medium, if the instructions get lost, the user can become frustrated.

Morag

Morag is directed to a system for creating a personalized photo album. The user acquires a set of images. These images can be from a digital camera or from digitized paper prints. The images are transmitted to a service provider that makes the album. The customer also transmits instructions to the service provider indicating how the images should be arranged in the photo album. Several images can be on a single album page and images can be combined into mosaics. The images are then automatically arranged into a photo album format by a computer based on the user's instructions, and the pages of the album can be printed out by the service provider and sent to the user. In one arrangement, a proof copy can be sent electronically to the user by email along with "computer-readable instructions" for viewing and

printing the proof copy. Like the above discussed art there are no instructions on the printed copy of the album pages.

D. The Prior Art vs. The Claimed Invention

1. Prima Facie Case Not Made

The Examiner has not made out a prima facie case of obviousness of claims 1, 3, 4, 6, 8, 10-15, 18 and 23-27 over FJCP and Monn. For example, claim 15 calls for a method that includes "following instructions for producing a series of digital images of a single same image where each of the digital images of the single same image have different characteristics". As discussed previously, the FJCP reference provides no instructions concerning how to create or what to do with the sheets of photographs, the greeting card photo, the greeting card stock or how to select a greeting for the greeting card. Monn addresses instructions for a box decoration and thus does not fill in this gap in FJCP. One would have to turn to a hypothetical common understanding to fill in this gap and there is no evidence of the common understanding before the Board. It is inappropriate to rely on general principles of engineering or physics or common understanding to fill in the gaps in the teachings of a reference (see Panduit v. Dennison, 774 F.2d 1082, 227 U.S.P.Q. 337 (Fed.Cir.1985) and Akzo v. Dupont, 810 F.2d 1148, 1 U.S.P.Q.2d 1704 (Fed.Cir.1987)). It is submitted that rejection over FJCP and Monn is defective and reversal of the rejection on this basis is requested.

The Examiner has not made out a prima facie case of obviousness of claims 20-22 over FJCP, Monn and Morag. For example, claim 21 calls for payment via a channel to a service provider over which images are sent. The Examiner has rejected this claim as obvious over FJCP, Monn and Morag with no comments about where this feature is found in the prior art and no line of reasoning concerning how or why this claim is obvious. A prima facie case of obviousness needs a line of reasoning (see MPEP section 2142). It is submitted that the rejection over FJCP, Monn and Morag is defective and reversal of the rejection on this basis is requested.

2. Claims 1, 3, 4, 6, 8, 10-15, 18 and 23-27 vs. FJCP and Monn

As noted above, it is asserted that FJCP discloses multiple sheet pictures, with pictures of two sizes on a single sheet, a greeting card with a greeting thereon and including a picture where the picture is formed on a photographic paper stock and the greeting is formed on a card stock, different from the photo stock.

As noted above, Monn discusses a kit for decorating a storage box designed to contain a photo album. Monn discusses a separate instruction sheet that discusses making a photocopy

of a photo and sticking the photo copy to the outside of the box and allows that the edges of the photocopy can be torn to tear off the border of the photocopy.

Claim 1

Claim 1 is directed to a method for making a scrapbook page ("a page which is usable in a scrapbook"). FJCP is about making portrait sheets and making greeting cards. There is no teaching or suggestion concerning making scrapbook pages in FJCP.

Claim 1 calls for "using a photographic digital image to produce a series of digital images of the same image where each of the digital images of the same image have different characteristics specified by a user", placing the series of digital images on a photographic print medium ("forming visual images of the series of different characteristics of images on a single photographic print medium distinct from the page") and on the same medium "forming a visual image of printed instructions for making the scrapbook on the single photographic print medium". That is, the instructions and visual images are formed on the photographic print medium.

In contrast, FJCP shows a greeting on a card stock and a picture on photo stock. And there is no suggestion in FJCP to place the greeting on the photo stock. Additionally, a greeting on a greeting card is not instructions much less instructions for making a scrapbook page. Monn shows a separate sheet for instructions and says nothing about combining the instructions with the photo and/or photocopy on the same medium, much less a photographic medium

Additionally method claim 1 calls for the user following the instructions to cut out the images and form the scrapbook page ("allowing the user to manually cut out the series of different characteristics of visual images from the medium in accordance with the instructions; and allowing the user to manually fix the cut out different visual images on the page forming a composite image on the page in accordance with the instructions which can be used in the scrapbook").

As discussed above, FJCP says and suggests nothing about scrapbook pages. Nor does FJCP discuss instructions for forming a composite image or manually cutting out or manually fixing. Monn also says and suggests nothing about forming a scrapbook page. Nor does Monn have or suggest instructions for cutting out images. Suggesting tearing off an offending border is not teaching or suggesting anything about cutting out the series of images.

For the above discussed reasons, it is requested that the rejection of claim 1 be reversed.

Claim 3

Claim 3 calls for the different characteristics of the series of images of claims to "include different sizes, colors, mirrored images or combinations thereof". FJCP has different size images on a sheet but not mirrored images or combinations of sizes, colors and mirrored images. Monn also says nothing about mirrored images or combinations of sizes, colors and mirrored images

For the above discussed reasons, it is requested that the rejection of claim 3 be reversed.

Claim 4

The Examiner has provided no basis for rejecting this claim other than the basis for claim 1.

Claim 4 is a method claim that much like claim 1 calls for forming images of different characteristics and instructions for a making a scrap book page on a single medium (as compared to the single "photographic print medium" of claim 1) and making the page via a composite image, and the reasons for reversal of the rejection made with respect to claim 1 are incorporated by reference herein. Additionally, FJCP and/or Monn do not teach or suggest forming the series of images and the instructions on a single medium, even when the medium need not be a photographic print medium as in this claim.

Additionally, claim 4 does not emphasize the cutting or fixing are manual operations by a user as in claim 1. That is, the operations could be performed by a machine. FJCP and Monn do not teach or suggest such cutting or fixing operations that need not be manual.

Further, claim 4 also calls for starting with a digital image for the series of images with different characteristics that could be a non-photographic, such as a graphic image. In FJCP the series of images on the image sheets are all photographic images. In Monn the image is also a photographic image. Neither FJCP nor Monn teach or suggest that the series images need not be photographic images.

For the above discussed reasons, it is requested that the rejection of claim 4 be reversed.

Claim 6

Claim 6 calls for fixing the cut out series of images using an adhesive. FJCP says nothing about cutting out or adhering a series of images. Monn discusses applying adhesive to the front and back of a single photocopy. Nothing is suggested about the features of claim 6.

For the above discussed reasons, it is requested that the rejection of claim 6 be reversed.

Claim 8

Claim 8 is a method claim that, much like claim 4, calls for forming images and instructions for a making a scrap book page on a single medium and making the a composite image page, and the reasons for reversal of the rejection made with respect to claim 4 are incorporated by reference herein.

Claim 8 also calls for "making a digital image of a desired subject." Both FJCP and Monn assume the existence of photographic print images, which do not necessarily have digital existence, and say or suggest nothing about actually making a digital image of a subject.

Claim 8 also calls for "annotating the page with other information or pictures and inserting such page into the scrapbook". There is no discussion of annotating that which has been created or of inserting the page into a scrapbook in FJCP or Monn.

For the above discussed reasons, it is requested that the rejection of claim 8 be reversed.

Claim 10

The Examiner has provided no basis for rejecting this claim other than the basis for rejecting claim 1.

Claim 10 is a method claim that, much like claim 8, calls for forming images and instructions for a making a scrap book page on a single medium and making the page composite image, and the reasons for reversal of the rejection made with respect to claim 8 are incorporated by reference herein.

Claim 10 also calls for forming an at least one image that itself is a series of images ("forming at least one visual image of the series of different characteristics of images on a single medium distinct from the page"), and cutting out and fixing that series image. As noted previously Monn has a single photocopy of an photo example and FJCP discloses a sheet of photos example. These examples are not an image that is a series of images. FJCP and Monn say nothing about this.

For the above discussed reasons, it is requested that the rejection of claim 10 be reversed.

Claim 11

The Examiner has provided no basis for rejecting this claim other than the basis for claim 1.

Claim 11 calls for the digital image to itself have plural images of the single image with the different characteristics. As noted previously Monn has a single photocopy of an photo example and FJCP discloses a sheet of photos example. These examples are not a digital image that is itself a plurality of images. FJCP and Monn say nothing about this.

For the above discussed reasons, it is requested that the rejection of claim 11 be reversed.

Claim 12

Claim 12 depends from claim 11 and is patentable over the prior art for the reasons discussed above with respect to claim 11.

Claim 13

Claim 13 calls for the different characteristics of the series of images of claims 12/11/10 to "include size, color content, mirrored images or combinations thereof". FJCP has different size images on a sheet but not mirrored images or combinations of size, color content and mirrored images. Monn also says nothing about mirrored images or combinations of sizes, colors and mirrored images

For the above discussed reasons, it is requested that the rejection of claim 13 be reversed.

Claim 14

Claim 14 calls adding to the montage of images created via the instructions of claim 10 by "providing other visual images on the scrapbook page either before or after fixing the visual image to the scrapbook page." FJCP and Monn say nothing about further adding to the montage.

For the above discussed reasons, it is requested that the rejection of claim 14 be reversed.

Claim 15

The Examiner has provided no basis for rejecting this claim other than the basis for rejecting claim 1.

Claim 15 is a method claim that like claim 1 calls for forming images of different characteristics and instructions for a making a scrap book page on the same medium and

making the scrapbook page composite image, and the reasons for reversal of the rejection made with respect to claim 1 are incorporated by reference herein.

Claim 15 also calls for the at least one image that itself is a series of images like claim 10 and the reasons for reversal of the rejection made with respect to claim 10 are incorporated by reference herein.

Claim 15 also calls for the method to include "following instructions for producing a series of digital images of a single same image where each of the digital images of the single same image have different characteristics". As discussed above, FJCP provides no instructions regarding producing images or how to use them. Monn provides instructions for making a box which is not relevant to the present invention feature.

For the above discussed reasons, it is requested that the rejection of claim 15 be reversed.

Claim 17

Claim 17 emphasizes that the instructions of claim 15 include instructions about "a visual arrangement of images and text". FJCP provides no instructions about images or text much less about the arrangement of images and text and Monn provides instructions about attaching a photocopy to a box. Thus, FJCP and Monn do not address this.

For the above discussed reasons, it is requested that the rejection of claim 17 be reversed.

Claim 18

The Examiner has provided no basis for rejecting this claim other than the basis for claim 1.

Claim 18 is a method claim that like claim 1 calls for forming images of different characteristics and instructions for a making a scrap book page on the same medium and making the scrapbook page composite image, and the reasons for reversal of the rejection made with respect to claim 1 are incorporated by reference herein.

Claim 18 also calls for additional information in visual form and for "printing the visual information and the instructions to facilitate a user cutting out the series of different characteristics of visual images from the medium and fixing them to a scrapbook page forming a composite image on the page." There is no such additional information printed along with the instructions taught or suggested by FJCP or Monn, as there are no instructions printed or information in FJCP and only a separate instruction sheet 20 in Monn.

For the above discussed reasons, it is requested that the rejection of claim 18 be reversed.

Claim 23

The Examiner has provided no basis for rejecting this claim other than the basis for the rejection of claim 1.

Claim 23 is a method claim that, much like claim 1, calls for forming images and instructions for a making a scrap book page on the same single medium and making the scrapbook page composite image, and the reasons for reversal of the rejection made with respect to claim 1 are incorporated by reference herein.

Claim 23 also calls for a user providing portion of an image and "modifying" the image to provide a modified image. FJCP and Monn both assume the existence of the images and say nothing about a user providing the images and particularly say nothing about modifying a provided image.

Claim 23 also calls for providing instructions for assembly in a "digital format". FJCP provides no instructions related to this and in Monn the instructions are on a sheet, not in digital form.

For the above discussed reasons, it is requested that the rejection of claim 23 be reversed.

Claim 24

Claim 24 calls for a product produced by the method of claim 23. FJCP discusses a sheet of images product and a greeting card product and Monn provides a kit. No scrapbook page method with the features described above is provided as a product or even suggested by FJCP or Monn.

For the above discussed reasons, it is requested that the rejection of claim 24 be reversed.

Claim 25

The Examiner has provided no basis for rejecting this claim other than the basis of claim 1.

Claim 25 is a method claim that, much like claim 1, calls for forming images and instructions for a making a scrap book page on a medium and making the scrapbook page composite image, and the reasons for reversal of the rejection made with respect to claim 1 are incorporated by reference herein.

Claim 23 also calls for allowing the user to supply an image and then calls for "allowing the user to specify reproduction of the image as a series of images with different characteristics associated with a scrapbook page style" and "creating the series of images responsive to the style." That is, the user can select a scrapbook style and the series is created in response to the style. Style selection capability and production of images responsive thereto is not provided, taught or even suggested by FJCP or Monn.

For the above discussed reasons, it is requested that the rejection of claim 25 be reversed.

Claim 26

The Examiner has provided no basis for rejecting this claim other than the basis for rejecting claim 1.

Claim 26 is a method claim that, much like claim 25, calls for forming images and instructions for a making a scrap book page on a medium and making the scrapbook page composite image, and allowing a user to select a style and producing the images responsive to that style and the reasons for reversal of the rejection made with respect to claim 25 are incorporated by reference herein.

Claim 26 also calls for "automatically selecting a set of scrapbook page assembly instructions responsive to the style where the instructions correlate to the series of images". No such operation is contemplated by FJCP or Monn.

For the above discussed reasons, it is requested that the rejection of claim 26 be reversed.

Claim 27

The Examiner has provided no basis for rejecting this claim other than the basis of claim 1.

Claim 27 is a method claim that, much like claim 25, calls for forming images and instructions for a making a scrap book page on a medium and making the scrapbook page composite image, and allowing a user to select a style and producing the images responsive to that style and the reasons for reversal of the rejection made with respect to claim 25 are incorporated by reference herein.

Claim 27 also calls for the images of the created series to each have "a unique printable identifier associated with each image". This unique identifier is printed on the medium along with the images and the instructions and the instructions for assembly "reference the unique

printable identifier associated with each image of the series of images." There is no such unique identifier or set of instructions provided or suggested by FJCP or Monn.

For the above discussed reasons, it is requested that the rejection of claim 27 be reversed.

3. Claims 20-22 vs. FJCP, Monn and Morag

As noted previously, Morag discusses creating a photo album and says nothing about scrapbooks. The user sends a set of different images to a service provider with instructions on how to make the album. The images are then arranged on photo album pages as per the instructions.

Claim 20

Claim 20 is a method claim that, much like claim 1 calls for forming images of different characteristics and instructions for a making a scrap book page on the same medium and making the page via a composite image, and the reasons for reversal of the rejection made with respect to claim 1 are incorporated by reference herein. Morag adds nothing to the disclosure of FJCP and Monn with respect to these features.

Claim 20 also calls for " the user sending a digital image over a communication channel to a service provider with instructions to the service provider, such service provider using the digital image produces a series of digital images of the same image where each of the digital images of the same image have different characteristics in accordance with the instructions and sends such digital images series to the user". FJCP and Monn do not address this. Morag does not teach or suggest anything about instructions to the service provider that instruct the production of "a series of digital images of the same image where each of the digital images of the same image have different characteristics."

For the above discussed reasons, it is requested that the rejection of claim 20 be reversed.

Claim 21

Claim 21 has been rejected with claim 20 without specific comment about this claim by the Examiner.

Claim 21 calls for payment via the channel to the service provider. The Examiner has pointed to no portion of the art that teaches or suggests this. The art does not teach or suggest this.

For the above discussed reasons, it is requested that the rejection of claim 21 be reversed.

Claim 22

Claim 22 has been rejected with claim 20 without specific comment about this claim by the Examiner. A prima facie case has not been made.

For the above discussed reasons, it is requested that the rejection of claim 22 be reversed.

4. Response to Particulars of Final Action

Response To Final Action Comments of Pages 2-5

As noted above, the present invention provides a photographic print medium with both visual images, such as the face of child, and a visual image of printed instructions for assembling a scrapbook page (see claim 1, for example). That is, the invention calls for the medium to include the instructions for making a scrapbook page and the series of pictures to be added to the scrapbook as a composite image on the scrapbook page.

On page 2, the Examiner alleges that FJCP discloses Portrait Greeting Cards and "the ability to provide print mediums with indicia" such as - Happy Easter -. FJCP (a print out of a web page) shows a facsimile of a greeting card that has a picture of a baby and the text words "Happy Easter". However, FJCP does not teach or describe that the picture and the text are on a photographic medium. FJCP does not say anything at all on this issue. As a result, the greeting card, as noted above, could be made of card paper stock with a photograph glued to or otherwise attached to the card paper stock. As can be seen, because FJCP does not even mention how the greeting card is constructed, FJCP does not teach or suggest that indicia, much less scrapbook page creation instructions, be printed on a photographic print medium. The text shown in FJCP could be printed on the card stock since it is shown separated from the baby picture image. Further, for this same reason or deficit in FJCP, FJCP does not teach or suggest that the instructions for making a scrapbook page be printed on the same photographic print medium as the image as is called for in the present invention. Monn does not teach or suggest this deficit in FJCP. Nor does Morag. For this reason it is submitted that the present invention is patentable over FJCP, Monn and Morag. Reversal of the rejection for this reason is requested.

The Examiner bases the rejection on an allegation that FJCP would "Inherently ... include providing instructions on the print medium ..." (see pages 2 and 6). The Board is reminded:

To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill in the art (see Continental Can Co. v Monsanto Co., 948 F.2d 1264, 20 USPQ2d 1746 (Fed. Cir. 1991)).

Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient (see In re Olerich, 666 F.2d 578, 212 USPQ 323 (CCPA 1981))

Since FJCP does not teach or suggest printing text on a print medium, much less a photographic print medium, as noted above, instructions on a print medium are also not taught or suggested. Further, greeting cards need no instructions, as it is common knowledge what is to be done with greeting cards and instructions are not necessarily present in the greeting cards depicted in FJCP. As a result, instructions on a print medium along with images are not inherently included in the greeting cards of FJCP. Monn also does not teach or suggest this deficit in FJCP. Nor does Morag. For this additional reason it is submitted that the present invention is patentable over FJCP, Monn and Morag. Reversal of the rejection for this reason is requested.

The Examiner appears to be base the rejection on an attempt to ignore the feature of the invention wherein the visual images for cut out and assembly, and the instructions for such cut out and assembly are provided on the same photographic print medium asserting that there no functional relationship there between. This is not the case. There is a function relationship between the medium and the instructions. As specifically recited in the claims, the instructions tell the user how to deal with the medium, particularly, "allowing the user to manually cut out the series of different characteristics of visual images from the medium in accordance with the instructions". As a result, it would be inappropriate for the Examiner to ignore this feature of the present invention. The Board is also reminded that effect must be given to all claim limitations (see In re Angstadt and Griffin, 537 F.2d 498, 190 U.S.P.Q. 214 (C.C.P.A.1976)). For this further reason, it is submitted that the present invention is patentable over FJCP and Monn (and Morag). Reversal of the rejection for this additional reason is requested.

The present invention also calls for a "series of images with different characteristics" being printed on the print medium with the instructions. FJCP only shows a single image on the greeting card (see claim 1, for example). Monn adds nothing to FJCP with respect to this feature. Nor does Morag. For this reason, it is submitted that the present invention is patentable over the art. Reversal of the rejection for this reason is requested.

As noted above, FJCP is directed to a system for making greeting cards while Monn is directed to a kit for decorating a photo album storage box with paper type cutouts. With respect to the attempt to combine the teachings of these two references the Board is reminded:

"[T]he best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing

together the prior art to defeat patentability--the essence of hindsight." In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

There is no such motivation in this case. FJCP is directed at giving the output produced, a greeting card, to a friend or relative. There is no reason for the user of FJCP to be motivated to remove the images from the greeting card or to otherwise cut-up the greeting card since such would destroy the purpose of the output of FJCP. Greeting cards are not intended to be cut-up. As a result, there would be no motivation to combine FJCP with Monn. For a similar reason, there is no motivation to combine FJCP with Morag.

The Board is also reminded:

The fact that the prior art teaches away from an invention is evidence that the invention is not obvious (see *Akzo v. USITC*, 808 F.2d 1471, 1 USPQ2d 1241 (Fed. Cir. 1986) and *In re Graselli*, 713 F.2d 731, 218 USPQ 769 (Fed. Cir. 1983)).

In the present situation, the purpose of FJCP of handing complete greeting cards to friends and relatives points or teaches away from cutting up such cards. Thus, the purpose of FJCP teaches away from a combination with Monn. The purpose of FJCP (give cards to friends) also teaches away from Morag (electronic photo album creation). For these further reasons, it is submitted that the present invention is patentable over the prior art. Reversal of the rejection for this further reason is requested.

The remaining independent claims 1, 4, 8, 10, 15, 18, 20, 23 and 25-27 also emphasize similar distinctions over the prior art. In particular claims 26 and 27, as noted previously, emphasize that there is a specific correlation between the images of the series of images and the instructions for assembling the scrapbook page where this is shown and described with respect to figure 1B of the application. Nothing in the prior art teaches or suggests such. It is submitted that the claims distinguish over the prior art.

Response To Final Action Comments of Pages 6-7

On pages 6 and 7 of the Action, the Examiner has mischaracterized the arguments made by the applicant as well as the teachings of the prior art, as discussed below.

On page 6, the Examiner states:

Applicant argues that FJCP does not teach or disclose that the picture and the text are on a photographic medium.

In fact, what the applicant has argued is that that FJCP does not teach or disclose that both the picture and the assembly instructions are formed on a single or contiguous piece of photographic medium. The Examiner, via this mischaracterization, predisposes the

invention to the Examiner's arguments by use of words like "the picture and the text are on a photographic medium" thereby not considering the invention as a whole.

The Examiner then asserts:

The examiner maintains that it is notoriously well-known to provide pictures of the kind disclosed by FJCP on a photographic medium. FJCP does not disclose the greeting card being made of card stock with a photograph glued to or otherwise attached to the card paper stock. Clearly, the pictures of FJCP are on the photographic medium.

This in effect has again not considered the invention as a whole.

The Examiner again mischaracterizes the invention in the following paragraph stating:

Applicant argues that FJCP fails to disclose printing instructions on the photographic print medium.

This in effect dilutes or ignores the true language of the claims. The language of the claims do not call for "printing instructions" and instead call for "printed instructions for making the scrapbook" (claims 1, 48, 10, 15, 18 and 20), "instructions ... containing information for assembling said at least one user supplied digital image" (claim 23), and "scrapbook page assembly instructions" (claims 25-27). This is very different from the characterization by the Examiner.

The Examiner maintains, incorrectly, that a greeting such as Happy Easter is equivalent to the explicit language used in the claims of the present invention. In the Examiner's words, "...including providing instructions on the print medium, since it would only depend upon the intended use of the print medium and the desired information to be displayed." There has been no demonstration in the cited art where the intended use is that the text printed with an image describes how to create a further finished or second product by following the contiguous printed assembly instructions and destroying the first product in the process.

The Examiner also states:

The examiner maintains that FJCP disclose that it is well known to provide any desired printing (for example, "Happy Easter") on the photographic print medium.

This is a mischaracterization of the prior art. FJCP does not allow the user to provide "any desired printing" but, if anything, rather constrains the user to the selections of the web page noted by the circles, "O". In addition, as asserted earlier, the greeting is on card stock not photographic stock in FJCP.

The Examiner then bases the rejection on the conclusion:

The examiner maintains that the sole difference between the present invention and the photographic print medium disclosed by FJCP is in the content of the

printed matter. Accordingly, there being no functional relationship between the substrate and the printed matter, as disclosed above, there is no reason to give patentable weight to the printed matter which, by itself, is non-statutory subject matter.

The Examiner has ignored the functionality between the printed assembly instructions and the medium and the content of the medium found in the claims, for example:

printed instructions for making the scrapbook on the single photographic print medium; allowing the user to manually cut out the series of different characteristics of visual images from the medium in accordance with the instructions; and allowing the user to manually fix the cut out different visual images on the page forming a composite image on the page in accordance with the instructions which can be used in the scrapbook

(see claim 1)

It is submitted that the invention of independent claims distinguishes over the prior art and reversal of the rejection is requested.


E. Conclusion

It is submitted that the Examiner has not made a case of obviousness by preponderance of the evidence and reversal of the rejection is requested.

Respectfully submitted,

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(VIII) Claims Appendix

1. A method of arranging a series of at least two visual images of different characteristics of the same image and fixing them to a page which is usable in a scrapbook, comprising:

using a photographic digital image to produce a series of digital images of the same image where each of the digital images of the same image have different characteristics specified by a user;

forming visual images of the series of different characteristics of images on a single photographic print medium distinct from the page;

forming a visual image of printed instructions for making the scrapbook on the single photographic print medium;

allowing the user to manually cut out the series of different characteristics of visual images from the medium in accordance with the instructions; and

allowing the user to manually fix the cut out different visual images on the page forming a composite image on the page in accordance with the instructions which can be used in the scrapbook.

3. The method of claim 1 wherein the characteristics include different sizes, colors, mirrored images or combinations thereof.

4. A method of arranging a series of at least two visual images of different sizes of the same image and fixing them to a page which is usable in a scrapbook, comprising:

using a digital image to produce a series of digital images of the same image where each of the digital images of the same image has a different size;

forming visual images of the series of different sizes of images on a single medium distinct from the page;

forming a visual image of printed instructions for making the scrapbook on the single medium;

cutting out the series of different sizes of visual images from the medium; and

fixing the cut out different sizes of visual images on the page forming a composite image on the page which can be used in the scrapbook.

6. The method of claim 4 wherein the cut out images are fixed by using an adhesive.

8. A method of making a scrapbook page, comprising:
making a digital image of a desired subject;
forming two or more visual images of the desired subject digital image of different sizes of the same image on a single medium to be fixed to a page and distinct from the page which can be used in a scrapbook;
forming a visual image of printed instructions for making the scrapbook on the single medium;
cutting out the series of images from the medium;
fixing the cut out images on the page forming a composite image on the page which can be used in the scrapbook; and
annotating the page with other information or pictures and inserting such page into the scrapbook.

10. A method of arranging a series of images taken from a single image to be fixed to a page which is usable in a scrapbook, comprising:
using a digital image of the single image to produce a series of digital images of the same single image where each of the digital images of the same single image have different characteristics;
forming at least one visual image of the series of different characteristics of images on a single medium distinct from the page;
forming a visual image of printed instructions for making the scrapbook on the single photographic print medium;
cutting out the at least one visual image from the medium; and
fixing the cut out of at least one visual image on the page forming a composite image on the page which can be used in the scrapbook.

11. The method of claim 10 wherein the at least one digital image includes a plurality of images of the single image having different characteristics and which are arranged as a single visual image to be cut out from the medium.

12. The method of claim 11 wherein the visual images are photographic images, thermal images, or inkjet images.

13. The method of claim 12 wherein the different characteristics include size, color content, mirrored images or combinations thereof.

14. The method of claim 10 wherein further including the step of providing other visual images on the scrapbook page either before or after fixing the visual image to the scrapbook page.

15. A method of arranging a series of images taken from a single image to be fixed to a page which is usable in a scrapbook, comprising:

providing a digital image of a single image;

following instructions for producing a series of digital images of a single same image where each of the digital images of the single same image have different characteristics;

forming at least one visual image of the series of different characteristics of images on a single medium distinct from the page;

forming a visual image of printed instructions for making the scrapbook on the single medium;

cutting out the at least one visual image from the medium; and

fixing the cut out at least one visual image on the page forming a composite image on the page which can be used in the scrapbook.

17. (previously presented) The method of claim 15 wherein the instructions include a visual arrangement of images and text.

18. A method of providing images and information to a user to permit the arrangement of a series of at least two pictures of different characteristics of the same image and fixing them to a page which is usable in a scrapbook, comprising:

using a digital image to produce a series of digital images of the same image where each of the digital images of the same image have different characteristics;

forming visual images of the series of different characteristics of images and instructions on a single medium distinct from the page;

forming a visual image of printed instructions for making the scrapbook on the single medium; and

printing the visual information and the instructions to facilitate a user cutting out the series of different characteristics of visual images from the medium and fixing them to a scrapbook page forming a composite image on the page.

20. A method of permitting a user to arrange a series of at least two visual images of different characteristics formed from the same image and fixing them to a page which is usable in a scrapbook, comprising:

the user sending a digital image over a communication channel to a service provider with instructions to the service provider, such service provider using the digital image produces a series of digital images of the same image where each of the digital images of the same image have different characteristics in accordance with the instructions and sends such digital images series to the user;

the user using the series of digital images forms visual images of the series of different characteristics of images on a single medium distinct from the page;

forming a visual image of printed instructions for making the scrapbook on the single medium;

the user cutting out the series of different characteristics of visual images from the medium; and

the user fixing the cut out different visual images on the page forming a composite image on the page which can be used in a scrapbook.

21. The method of claim 20 further including making payment via the channel to the service provider for providing the series of digital images.

22. The method of claim 20 wherein the channel is a local channel or the Internet.

23. A method of making at least two images which can be used in a scrapbook page, comprises:

providing at least one portion of at least one digital image provided by a user;

modifying the at least one digital image to provide a modified digital image of the same image;

providing instructions in a digital format containing information for assembling said at least one user supplied digital image; and

producing visual images from the at least one digital image, the modified digital image and the instructions on at least one single medium distinct from the page so that the visual images can be assembled in a scrapbook forming a composite image on the page.

24. An image product produced by the method of claim 23.

25. A method of allowing a user to create a scrapbook page, comprising:

allowing the user to supply an image for the scrapbook;

allowing the user to specify reproduction of the image as a series of images with different characteristics associated with a scrapbook page style;

creating the series of images responsive to the style;
selecting a set of scrapbook page assembly instructions responsive to the style;
printing the images and the instructions on a medium distinct from the page; and
allowing the user to use the images to assemble the scrapbook page in accordance with instructions forming a composite image on the page.

26. A method of allowing a user to create a scrapbook page, comprising:
allowing the user to supply an image for the scrapbook;
allowing the user to specify reproduction of the image as a series of images with different characteristics associated with a scrapbook page style;
creating the series of images responsive to the style;
automatically selecting a set of scrapbook page assembly instructions responsive to the style where the instructions correlate to the series of images;
printing the images and the instructions on a medium distinct from the page; and
allowing the user to use the images to assemble the scrapbook page in accordance with instructions forming a composite image on the page.

27. A method of allowing a user to create a scrapbook page, comprising:
allowing the user to supply an image for the scrapbook;
allowing the user to specify reproduction of the image as a series of images with different characteristics associated with a scrapbook page style;
creating the series of images responsive to the style wherein each image of the series of images has a unique printable identifier associated with each image;
displaying a set of scrapbook page assembly instructions responsive to the style where the instructions reference the unique printable identifier associated with each image of the series of images;
printing the images, the unique printable identifier and the instructions on a medium distinct from the page; and
allowing the user to use the images to assemble the scrapbook page in accordance with the instructions referencing each image by the associated unique printable identifier and forming a composite image on the page.